

**IN THE UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS**

EGERA, INC.,

Plaintiff,

v.

CISCO SYSTEMS, INC.,

Defendant.

Civil Action No. 1:16-cv-11613-RGS

JURY TRIAL

**EGERA'S NOTICE OF SUPPLEMENTAL AUTHORITY REGARDING CISCO'S
PROPOSED FINDINGS OF FACTS AND CONCLUSIONS OF LAW REGARDING
INVENTORSHIP OF THE '430 PATENT**

Cisco asserts that “courts have found inventors to be non-joined even when the inventors . . . did not themselves believe they were inventors.” Dkt. 217 at 25-26 (citing *Winbond Elecs. Corp. v. Int’l Trade Comm’n*, 262 F.3d 1363, 1368–69 (Fed. Cir. 2001)). Cisco’s assertion is not based on the case holding, but an incorrect summary of the ALJ’s prior holding. In that summary, the Federal Circuit states that “[i]n his initial determination of March 19, 1998, the administrative law judge concluded that an incorrect listing of inventors prevented enforcement of the ’903 patent.” 262 F.3d at 1368. Egenera has attached hereto the ALJ and Commission opinions describing the administrative proceedings. Cisco’s misreading of the case, while understandable given the procedural history, should not be accepted by this Court.

The ALJ actually held that “it has not been established that the inventorship on the patent is in error.” *In the Matter of Certain EPROM, EEPROM, Flash Memory, and Flash Microcontroller Semiconductor Devices and Products Containing Same*, Inv. No. 337–TA–395, 1998 WL 223194, at *209. COL#8 (March 19, 1998) (Ex. 1). Several entities argued that Mr. Gupta and/or several other individuals were inventors, but Mr. Gupta testified that he was not an inventor and the ALJ found that the entities failed to prove otherwise. *Id.* at *52–53.

The Commission reversed based on the Federal Circuit’s opinion in *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456 (Fed. Cir. 1998) that was issued shortly after the ALJ’s initial determination. *In the Matter of Certain EPROM, EEPROM, Flash Memory, and Flash Microcontroller Semiconductor Devices and Products Containing Same*, Inv. No. 337–TA–395, 1998 WL 35428257, at *9–10 (July 9, 1998) (Ex. 2). *Ethicon* held that “[t]he contributor of *any disclosed means* of a means-plus-function claim element *is a joint inventor* as to that claim, *unless* one asserting sole inventorship can show that the contribution of that means was simply a reduction to practice of the sole inventor’s broader concept.” *Id.* (quoting *Ethicon*, 135 F.3d at

1463 (emphases original)). The Commission noted that the named inventor was “a marketing person who has never designed semiconductor products” and “admit[ted] that he did not conceive any of the circuitry by which the elements of the patent claims at issue were realized.” *Id.* In light of this, the Commission held “the ’903 patent is unenforceable for failure to name an inventor,” *id.*, but did not hold who was the additional inventor. The Commission did not hold that Mr. Gupta was an inventor, but instead noted that he could “presumably” be “the person(s) who selected particular circuit structures for each of the means plus function claim elements.” *Id.*

Importantly, the Commission analyzed the *Ethicon* exception: the contributor of any disclosed means is not an inventor if “the contribution of that means was simply a reduction to practice of the sole inventor’s broader concept.” *Id.* The Commission held that the exception did not apply given that the sole-named inventor had “never designed semiconductor products in his career” and that the sole inventor “admit[ted] that he did not conceive any of the circuitry by which the elements of the patent claims at issue were realized.” *Id.*¹

Accordingly, the parties have identified no case in which an alleged inventor testified that they are not an inventor, but the court found otherwise. Further, the *Ethicon* exception is an important caveat to the law on inventorship of means plus function claims: the contributor of a disclosed means is not a joint inventor if “the contribution of that means was simply a reduction to practice of the sole inventor’s broader concept.” *Ethicon*, 135 F.3d at 1463.

¹ The patent owner subsequently obtained a certificate of correction of the named inventors to add Mr. Gupta, who appeared to then agree he was an inventor. On remand, the ALJ again found that Mr. Gupta was not an inventor. *In the Matter of Certain EPROM, EEPROM, Flash Memory, and Flash Microcontroller Semiconductor Devices and Products Containing Same*, Inv. No. 337-TA-395, 2000 WL 1839715, at *23–36 (May 17, 2000) (Ex. 3); The Commission again took issue with the ALJ’s findings, concluding “respondents and intervenor did not prove by clear and convincing evidence that incorrect inventors are listed on the ’903 patent’s certificate of correction.” *In the Matter of Certain EPROM, EEPROM, Flash Memory, and Flash Microcontroller Semiconductor Devices and Products Containing Same*, Inv. No. 337-TA-395, 2000 WL 1810084, at *28–36 (December 11, 2000) (Ex. 4).

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a copy of this document filed through the Electronic Case Filing (“ECF”) system on January 28, 2019, will be sent electronically to the registered participants as identified on the Notice of Electronic Filing.

/s/ John B. Campbell

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